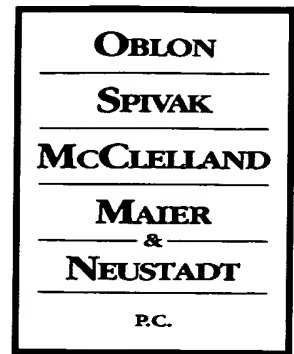




Docket No.: 205553US3

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



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RE: Application Serial No.: 09/824,769

Applicants: Atsushi ITOH

Filing Date: April 4, 2001

For: DISPLAY DEVICE

Group Art Unit: 2875

Examiner: S. KRISHNAN

SIR:

Attached hereto for filing are the following papers:

REQUEST FOR RECONSIDERATION

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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Atty. Docket No.: 205553US-3

8/Reg. for Recon.
6.11.03
C. Moore



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Atsushi ITOH

SERIAL NO: 09/824,769

FILED: APRIL 4, 2001

FOR: DISPLAY DEVICE

GROUP ART UNIT: 2875

EXAMINER: S. KRISHNAN

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REQUEST FOR RECONSIDERATION

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Office Action mailed March 17, 2003, please reconsider the above-identified patent application for the reasons, as follows:

REMARKS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-25 are pending in this application.

In the outstanding Office Action, claims 1-4 were rejected to under 35 U.S.C. § 102(b) as being anticipated by *Coleman*, claims 5 and 7-18 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Tajima*, claims 9-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tajima* in view of *Uchiyama et al.*, claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tajima* in view of *Murai*, claims 20, 21, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tajima* in view of

Hasegawa et al., and claims 6 and 22-24 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant respectfully traverses the rejection of claims 1-4 under 35 U.S.C. § 102(b) as being anticipated by *Coleman* for the following reasons.

As a quick synopsis of the applied prior art reference, Applicant hereby refers to the abstract of *Coleman*, as follows.

Coleman discloses a portable display device having a base comprising running gear which includes a plurality of wheels and a pulling tongue wherein the wheels may be detachably secured to the base such that the base may be permanently affixed to a given location. A sign is reciprocally mounted on the base by means of a supporting frame such that the sign may be raised or lowered to any desired position through the operation of a lifting mechanism in the form of a power or manually operated winch connected to the sign by a pulley and cable arrangement. Lights may be arranged on both the interior and exterior of the sign and operated by a power supply, in the form of a battery or generator which also may be carried on the base of the sign.

Applicants respectfully submit that *Coleman* does not disclose or suggest, as is recited in claim 1, mechanical parts for fixing the electronic parts to specified positions within the display portion, wherein the mechanical parts comprise at least a thin metallic frame, and nuts mounted through the thin metallic frame by being caulked or by being directly threaded.

The Office Action alleges that *Coleman* discloses:

a display device comprising a display portion of planar type including electronic parts for driving the display portion through external signals located inside the display portion (elements 114/116), mechanical parts for fixing the electronic parts to specified positions within the display portion comprising at least a thin metallic frame (element 14), and nuts (see element 130) mounted through the thin metallic frame). See figures 1, 8, and 9. The limitation

existing in the claim that the nuts are mounted by being caulked or directly threaded is considered to be a product by process limitation and thus not given any patentable weight. Patentable weight is only given to the product claimed, not the process by which it is claimed.

Applicant respectfully submits that reference numeral 14 represents a support frame which removably mounts a sign 16. Referring to col. 7, lines 1-6, of *Coleman*, the sign 16 comprises a peripheral, rectangularly shaped frame 110 designed to support display panels 112 on each side thereof, and the sign 16 is arranged such that there is sufficient space on the interior of the sign 16, between display panels 112, to arrange a bank 114 of lights 116. It is clearly the frame 110 which is the mechanical part for fixing the electronic parts (i.e., the bank 114 of lights 116) to specified positions within the display portion, if any, and not the support frame 14. The support frame has nothing to do with the fixing the electronic parts (i.e., the bank 114 of lights 116) to specified positions within the display portion, the support frame 14 only acting to movably support the sign 16 on the base 12 via the collars 108. Thus, Applicant respectfully submits that *Coleman* does not disclose Applicant's claim limitation of "mechanical parts for fixing the electronic parts to specified positions within the display portion, wherein the mechanical parts comprise at least a thin metallic frame; and nuts mounted through the thin metallic frame . . .," because the only frame in *Coleman* that could be meet the claim limitation of being a mechanical part for fixing the electronic parts to specified positions within the display portion" is the frame 110 and not the support frame 14, and the frame 110 clearly does not have nuts mounted therethrough.

Even assuming arguendo that the support frame 14 could be considered to be meet the claim limitation of "mechanical parts for fixing the electronic parts to specified positions within the display portion, wherein parts comprise at least a thin metallic frame," Applicant respectfully submits that as is clearly shown in Figs. 8 and 9, *Coleman* does not disclose Applicant's claim limitation of "nuts mounted through the thin metallic frame"

Reference numeral 130 of *Coleman* represents a bolt and nut assembly (see col. 7, lines 36-37), wherein a bolt has a nut screwed on the end thereof. It is only portions of the bolt that go through the support frame 14, the nut being screwed on the end of the bolt, but not going through the frame as is specifically recited in present claim 1 and clearly shown by the present invention in FIGS. 3, 5, 6, and 7 (see nut 7 being through metallic frame 2).

Further, with respect to the Office Action's allegation that the recitation that the nuts mounted through the thin metallic frame "by being caulked or by being directly threaded" is a product-by-process limitation, Applicant respectfully submits such limitation is not a product-by-process limitation because the limitation strictly recites an element or feature of an article of manufacture and does not recite procedural steps of any process.

Even assuming arguendo that the recitation of "by being caulked or by being directly threaded" does give rise to being a product-by-process limitation, the examiner must still glean whatever structure can be gleaned from such product-by-process limitation, which means that the examiner must at least show a reference having nuts mounted through the thin metallic frame (by whatever method or process) and *Coleman* clearly does show a nut through metal frame 14. Rather, *Coleman* only shows a bolt going through the metal frame 14 and the nut fastened on the end of the bolt going through the metal frame 14, and this is not enough to meet the specifically recited claim language.

Thus, Applicant respectfully submits that *Coleman* does not anticipate claim 1. Based on the foregoing, Applicant respectfully requests withdrawal of the rejection of claims 1-4 under 35 U.S.C. § 102(b) as being anticipated by *Coleman*.

Applicant traverses the rejections of claims 5 and 7-18 under 35 U.S.C. § 102(e) as being anticipated by *Tajima* and the rejections of claims 9-12, 19, 20, 21, and 25 under 35

U.S.C. § 103(a) as being unpatentable over *Tajima* in combination with any of *Uchiyama et al.*, *Murai*, and *Hasegawa et al.* for the reasons as follow.

First, it is completely unclear whether the Office Action intends to reject claims 1 and 4 under the 35 U.S.C. § 102(e) rejection of claims 5 and 7-18 based upon *Tajima*. More particularly, the Office Action alleges that *Tajima* discloses:

a display device comprising a display portion of planar type including electronic parts for driving the display portion through external signals located inside the display portion, and mechanical parts for fixing the electronic parts to specified positions within the display portion, and mechanical parts for fixing the electronic parts to specified positions within the display portion comprising at least a thin metallic frame.

This appears to be the recitation of most of the limitations of claim 1, except for the limitation of "nuts mounted through the thin metallic frame by being caulked or by being directly threaded." Yet, the Office Action does not list claim 1 as being one of the claims rejected under the 35 U.S.C. § 102(e) anticipation rejection based upon *Tajima*.

Then, the Office Action goes on to state that *Tajima* discloses:

nuts (element 58) designed to mount a predetermined accessory part (woofer speaker, an electric circuit part concerned in the function of the display device,) to the display device.

This appears to be the recitation of the limitations of claim 4. Yet, claim 4 has also not been included in the list of claims that are being rejected under the 35 U.S.C. § 102(e) anticipation rejection based upon *Tajima*.

Then, the Office Action goes on to state that:

The nuts are disclosed as being mounted on a lateral surface of the thin metallic frame of the display device, see figures 14 and 15.

This appears to be the recitation of the limitations of claim 5. Yet, claim 5 depends upon claim 4 which in turn depends upon either claim 1 or claim 2, and the Office Action has not listed any of claims 1, 2, and 4 as being rejected under the 35 U.S.C. § 102(e) anticipation rejection based upon *Tajima*.

Further, with respect to the rejection of claim 19, the Office Action indicates that *Tajima* "discloses the display device of claim 1." However, claim 1 has not been listed as one of the claims being rejected under the 35 U.S.C. § 102(e) anticipation rejection based upon *Tajima*.

Thus, Applicant respectfully submits that it is not at all clear whether the Office Action intends to reject claim 1 and 4 under the 35 U.S.C. § 102(e) anticipation rejection based upon *Tajima*.

Further, on page 3, line 18 through page 4, line 3, in the section rejecting claims 5 and 7-18 under 35 U.S.C. § 102(e) as being anticipated by *Tajima*, the Office Action alleges with respect to claims 13 and 15-18 that *Tajima* discloses:

that it is well known in the art to employ an electron-emitting device, a display device utilizing plasma discharge, a display device using liquid crystal, and a display device using a fluorescent display tube as thin planar image display devices. Applicant has not disclosed how the invention depends on utilizing specifically one of the above devices. Other alternatives include minute optical reflectors known as digital micro-mirror devices. The result of each of these methods are the same, to enable an image to display on the screen. **Therefore, it would have been obvious to one skilled in the art to choose any one of these methods to use a the method of display.**

It is not at all clear what the examiner is trying to say in the above-quoted passage from the Office Action, but it appears that she is using an "it would have been obvious" statement in an anticipation rejection which is **improper** and perhaps, claims 13 and 15-18 should have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tajima*, instead of the 35 U.S.C. § 102(e) anticipation rejection based on *Tajima*.

Based on the foregoing, Applicant respectfully refers the examiner's attention to 37 C.F.R. § 1.104(c)(2), wherein it is stated that:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, ***the particular part relied on must be designated as nearly***

as practicable. The pertinence of each reference, if not apparent must be clearly explained and each rejected claim specified. (Emphasis added).

In addition, the Manual of Patent Examining Procedure (hereinafter "MPEP") § 706 states that:

. . . The goal of examination is to *clearly articulate any rejection early in the prosecution process* so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity . . . (Emphasis added).

Further, MPEP § 706.02(j) states that:

[Especially concerning rejections under 35 U.S.C. § 103(a)] It is important for an examiner to *properly communicate the basis for a rejection* so that the issues can be identified early and the applicant can be given fair opportunity to reply. . . (Emphasis added).

Applicants respectfully submit that the Office Action is totally unclear as to whether claims 1 and 4 are being rejected under 35 U.S.C. § 102(e) as being anticipated by *Tajima* since claims 1 and 4 are not listed among the claims being rejected on page 3, line 4, of the Office Action, although it would appear that in order to reject any of the dependent claims, which are all either directly or indirectly dependent upon claim 1, the Office Action would have to reject claim 1 under 35 U.S.C. § 102(e) as being anticipated by *Tajima*. However, even if the Office Action did intend to reject claims 1 and 4 under 35 U.S.C. § 102(e) as being anticipated by *Tajima*, the Office Action would have to give some indication, either by reference numerals or figure numbers or column and line numbers, what structure in *Tajima* corresponds to the recited structural limitations of the present invention, and this has not been done.

Therefore, Applicant respectfully submits that the foregoing explanations clearly demonstrate that a *prima facie* case of anticipation with respect to the 35 U.S.C. § 102(e) rejection based upon *Tajima* and a *prima facie* case of obviousness with respect to the 35 U.S.C. § 103(a) rejection based upon *Tajima* in view of any of *Uchiyama et al.*, *Murai*, and

Hasegawa et al., have not been made out, and that the pending claims should be found to be allowable.

However, if the examiner persists in rejecting any claim, Applicant earnestly requests that the examiner specifically identify, by figure number and reference numeral and/or by column and line number, which items in the cited prior art are being relied upon to teach each claim limitation. This specific correlation between disposed items and claim limitations is needed in order to expedite examination and provide Applicant a fair opportunity to evaluate any issue and respond accordingly.

Even assuming *arguendo* that *prima facie* cases have been made out for the rejection of claims 5 and 7-18 under 35 U.S.C. § 102(e) as being anticipated by *Tajima* and the rejection of claims 9-12, 19, 20, 21, and 25 under 35 U.S.C. § 103(a) as being unpatentable over *Tajima* in combination with any of *Uchiyama et al.*, *Murai*, and *Hasegawa et al.*, Applicant respectfully submits that *Tajima* fails to disclose, teach or suggest "nuts mounted through the thin metallic frame" as is clearly recited in independent claim 1.

More particularly, as a quick synopsis of the applied prior art references, Applicant hereby refer to the abstracts of *Tajima*, *Uchiyama et al.*, *Murai*, and *Hasegawa et al.*, as follows.

Tajima discloses an image display device including a display panel, and a housing that includes a frame body arranged on the circumference of the display panel and a back cover arranged on the back of the display panel. The frame body has a structure for sandwiching therein the display panel.

Uchiyama et al. disclose an attachment structure of a display device which enables the outer dimensions to be reduced while maintaining the display area and makes assembling simple. More specifically, the present invention is directed to an attachment structure for a

display device for attaching a display device comprising a display part (102) of a shape of a rectangular plate and a frame part (104) arranged in the outer periphery thereof to an external casing (200) having a rectangular opening part (204) formed of a side wall, in which an aperture (106) is formed in at least one of two opposing edges of the frame (104) in the direction parallel to the plane of the display part (102) and a bracket member (210) fixed to the external casing (200) is provided with a pin (218) which is engageable with the aperture (106) and is or is not moveable in the direction parallel to the plane of the display part (102).

Murai discloses a flat panel display device including a driver circuit board, a resin frame, and a metal sheet, the edge portion of which is provided with a U-shaped engagement portion to receive the resin frame. The metal sheet reinforces the resin frame and also shields electromagnetic wave noises from the driver circuit board.

Hasegawa et al. disclose a liquid crystal display device and a data processing device, which can have their frame portions reduced in area to reduce the size and weight by extracting the terminals of video signals to only one side of a liquid crystal display panel and by arranging a video signal line driving circuit substrate to be connected with the terminals, only at one side of the display panel.

None of *Tajima*, *Uchiyama et al.*, *Murai*, and *Hasegawa et al.* teach or suggest, as is now recited in amended independent claim 1, a display device comprising: a display portion of planar type, the display portion including: electronic parts for driving the display portion through external signals, the electronic parts being located inside of the display portion; mechanical parts for fixing the electronic parts to specified positions within the display portion, wherein the mechanical parts comprise at least a thin metallic frame; and nuts mounted through the thin metallic frame by being caulked or by being directly threaded.

More particularly, none of *Tajima*, *Uchiyama et al.*, *Murai*, and *Hasegawa et al.* teach or suggest a thin metallic frame for fixing electronic parts to specified positions wherein nuts are “mounted through the thin metallic frame.”

The Office Action appears to be alleging that the rail nut 58 of *Tajima* as illustrated in Figs. 14 and 15 are “nuts mounted through the thin metallic frame.” However, Applicant respectfully submits that while the rails nuts 58 are used to mount the left and right speaker units 53-a and 53-b, the left and right stand units 54-a and 54-b, and the communication unit 55, the rail nuts 58 are not “mounted through the thin metallic frame.” Indeed, as shown in Fig. 15, the rail nut 58 is mounted on the male screw 57-a and then the male screw 57-a and the rail nut 58 ride in groove 41-d as is shown in perspective view in Fig. 14 and as is shown in cross-sectional view in Fig. 9A. From Fig. 9A, it is clear that reference character 41-d represent only a groove in the outer periphery of the outer frame 41, but is not a hole penetrating the outer frame 41 and therefore, it is clear that the rail nuts 58 are not “mounted through the thin metallic frame.”

Based on the foregoing, Applicant respectfully requests withdrawal of the rejections of claims 5 and 7-18 under 35 U.S.C. § 102(e) as being anticipated by *Tajima*, withdrawal of the rejection of claims 9-12, 19, 20, 21, and 25 under 35 U.S.C. § 103(a) as being unpatentable over *Tajima* in view of any one of *Uchiyama et al.*, *Murai*, and *Hasegawa et al.*, and allowance of claims 1-25.

In view of the foregoing, claims 1-25 are believed to be in condition for allowance,
and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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